REMARKS

Reconsideration and withdrawal of the rejections set forth in the Office action dated December 16, 2004 are respectfully requested. Applicants thank the Examiner for an indication that claims 10-19 are allowed.

I. Amendments

Claims 1 and 20 are amended to recite the housing includes a tissue-conforming surface capable of conforming to the contour of the tissue. Basis for this amendment can be found in original claim 8 and on page 18, lines 4-6.

No new matter is added by way of these amendments.

II. Interview Summary

Applicants thank the Examiner granting an interview regarding the above-referenced application on May 12, 2005. The participants were Examiner Rollins (USPTO) and Peter Dehlinger (Applicant's representative). This written summary is submitted in accordance with MPEP §713.04.

1. No exhibits were shown or discussed.

2. Claim 1 was discussed.

3. Cosman et al. (U.S. Patent No. 6,530,922) was discussed.

4. Requirements for overcoming the outstanding rejections were generally discussed as well as the nature of the rejection. Applicant's representative proposed a supplemental amendment to claim 1 reciting "a tissue conforming surface, capable of conforming to the contour of the tissue."

5. An agreement was not reached.

III. Rejection under 35 U.S.C. §102

Claims 1-7 were rejected under 35 U.S.C. §102(e) as allegedly anticipated by Cosman *et al.* (U.S. Patent No. 6,530,922).

These rejections are respectfully traversed.

A. The Present Invention

The present invention, as embodied by claim 1, describes a method of controlling an ablation volume depth during surface treatment comprises (a) providing an apparatus, where the apparatus comprises (i) a housing having a proximal end and a distal end including a tissue-conforming surface capable of conforming to a contour of the tissue, having at least one aperture, and the housing defines an interior, (ii) an energy delivery device including a plurality of electrodes, each with a tissue penetrating distal end, the plurality of electrodes configured to be advanced from the housing interior through the at least one aperture and into a target tissue site to define an ablation volume at least partly bounded by the tissue surface, (iii) an advancement device coupled to the energy delivery device, where the advancement device is configured to selectively advance individual electrodes of the plurality of electrodes from the housing interior to a selected deployment depth. The method further comprises (b) positioning the tissue contact surface on a target tissue surface, (c) selectively advancing the plurality of electrodes using the advancement device to the selected deployment depth beneath a tissue surface while avoiding a critical structure, (d) delivering ablative energy from the energy delivery device (e) creating an ablation volume at a controlled depth below the tissue surface responsive to the electrode advancement device, and (f) minimizing injury to the critical structure responsive to the electrode deployment depth.

B. The Prior Art

COSMAN ET AL. describe a device for ablation of tissue. The device generally includes a cluster or array of electrodes. Various embodiments of the device are described. In one embodiment (Fig. 7, Col. 12, lines 20-47), the device includes electrodes attached to a plunger hub, which slides in a carrier or sheath.

In another embodiment, illustrated in Fig. 10 (Col. 15, lines 24-45), the ablation device contains three electrodes that are inserted into an organ using a

guide block. (Col. 15, lines 42-44). The guide block serves to direct the electrodes to the desired site within the tumor.

C. Analysis

According to the M.P.E.P. § 2131, "A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference".

The method of instant claims 1 and 20 include providing an apparatus including a housing having a distal end including a tissue-conforming surface capable of conforming to the contour of the tissue.

Cosman *et al.* fail to teach this claim element. Specifically, Cosman *et al.* nowhere show providing an apparatus that includes a tissue-conforming surface. As seen in Figs. 1 and 7, neither the guide block nor the plunger include a tissue-conforming surface.

Accordingly, Applicants submit that standard of strict identity to maintain a rejection under 35 U.S.C. § 102 has not been met and withdrawal of the rejections under 35 U.S.C. § 102(e) is respectfully requested.

IV. Rejections under 35 U.S.C. §103

Claims 8, 9, and 20 were rejected under 35 U.S.C. §103 as allegedly obvious over Cosman *et al.* further in view of Behl *et al.* (U.S. Patent No. 6,337,998). This rejection is respectfully traversed.

A. The Present Invention

The instant method, according to claims 8 and 9, is described above. The method according to claim 20 includes providing an apparatus comprising a housing having a tissue-conforming surface capable of conforming to a contour of the tissue.

B. The Prior Art

COSMAN ET AL. is described above.

BEHL ET AL. describe a system for treatment of target region beneath a tissue surface comprising a probe for deploying an electrode array within the tissue and a cover for engaging the tissue surface above the treatment site. The cover may be a rigid plate and may be clipped or otherwise removably attached to the probe. The cover may comprise electrode(s) or be electrically neutral.

Analysis

According to the MPEP § 2143, one of the three basic criteria that must be met to establish a prima facie case of obviousness is that the prior art references (or references when combined) must teach or suggest all the claim limitations.

As noted above, Cosman *et al.* fail to teach providing a tissue surface treatment apparatus including a housing having a tissue-conforming surface capable of conforming to the contour of the tissue.

The teaching in Behl *et al.* does not make up for this deficiency. The system of Behl *et al.* includes (i) a probe for deploying an electrode array at a tissue site and (ii) a surface electrode for engaging the tissue surface above the treatment site. As seen in Fig. 2, the surface electrode is a rigid plate and does not include a tissue-conformable surface.

Because neither of the references, alone or in combination, teach all the claim limitations of the present invention, the standard for obviousness has not been met. Accordingly, Applicants respectfully request withdrawal of the rejections under 35 U.S.C. §103.

V. Conclusion

In view of the foregoing, Applicants submit that all of the claims pending in the application are in condition for allowance. A Notice of Allowance is therefore respectfully requested.

The Examiner is invited to contact Applicants' representative at (650) 838-4410 if it is believed that prosecution of this application may be assisted thereby.

Respectfully submitted,

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